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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/913,862	08/20/2001	Frederic Dat		5677

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EXAMINER
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BOTTORFF, CHRISTOPHER

ART UNIT	PAPER NUMBER
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3618

DATE MAILED: 07/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/913,862

Applicant(s)

DAT, FREDERIC

Examiner

Christopher Bottorff

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 9-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 August 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application):  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other:

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### **DETAILED ACTION**

The amendment filed April 29, 2003 has been entered. Claims 1-8 are canceled. Claims 9-28 are added and represent the pending claims. Also, the amendment overcomes the previous objection to the specification and claim rejections under 35 U.S.C. 112, second paragraph.

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the return spring recited in line 2 of both claims 15 and 17 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claims 9 and 20 state on lines 18-19 and 17-18 respectively that the lower part of each branch is housed above one part of the side part of the heel piece. However, the heel piece is a shoe attachment and can be separated from the lower part of each branch. As a result, the condition in which the lower part is housed above the side part only exists when the heel piece is locked into position in the base. When the heel piece is suspended above the base before it is lowered into position, or anytime a user separates the heel piece and the lower part, the lower part is not housed above the side part. Since the heel piece may be moved away from the base on the snowboard, this limitation is indefinite.

Also, claim 27 recites the limitation "the normal position of use" in line 4.

There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

Claims 9, 11, 20, and 23 are rejected under 35 U.S.C. 102(e) as being anticipated by Paris US 5,899,483.

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Paris discloses a device having a base 8, a heel release 7, and a heel-piece 11, 12. See figures 1-4. The base 8 includes a sole fixed flat on the snowboard and two lateral wings extending up the sides of the sole corresponding to the two lateral sides of a shoe. The heel release 7 includes an upper part and lower part, wherein the upper part extends vertically and is placed transversally at the rear of the base. The heel release 7 is divided in its lower part into two lateral branches 18, 19 that each interlock to a wing of the base by a pin 9. Each branch has a lower part located under the pin 9, is housed under the pressure of a spring 24, and is above one part of a side part of the heel piece on the shoe when the heel piece is locked into position in the base. Each spring 24 is an angular action spring that surrounds the corresponding pin, and has one end pressing on the base and the other end contacting the corresponding lateral branch of the heel release. See column 5, lines 8-19. Also, the heel-piece 11, provided on the shoe, includes two lateral side extensions that are adapted to cooperate with stop means 16, 17, 20 provided on each of the wings. See Figures 2 and 4; column 3, lines 62-67; and column 4, lines 4-6 and lines 20-31.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 13, 17, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paris US 5,899,483 in view of Gignoux US 6,105,993.

Paris does not disclose a mobile blade or a handle. However, Gignoux teaches a mobile blade 36 that is linked to the back part of a heel release 26 by one of its ends, forms a loop behind the back part of the heel release, and another end that is free passes through an opening in the heel release to come into contact with the heel of a shoe. See figure 1. Also, the blade serves as a prehension handle that is easy to hold.

From the teachings of Gignoux, providing the device of Paris with a mobile blade, that also serves as a handle, would have been obvious to one of ordinary skill in the art at the time the invention was made. This would offer a user a convenient means of holding the heel release.

Claim 18 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paris US 5,899,483 in view of Quintana et al. US 5,947,507.

Paris does not disclose two housings on the front of the wings of a base adapted to accommodate flat parts on the sides of a shoe sole. However, Quintana et al. teaches the old and well known practice of forming two housings 46 on the front wings of a base with shapes that correspond to the flat parts on the sides of a shoe such that the housings are adapted to accommodate flat parts on the sides of a shoe sole. See figures 1 and 5. From the teachings of Quintana et al., providing the device of Paris with two housings on the front of the wings of a base would have been obvious to one of

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ordinary skill in the art at the time the invention was made. This would effectively secure the boot to the base.

***Allowable Subject Matter***

Claims 10, 12, 14-16, 19, 22, 24, and 26-28 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

Applicant's arguments filed April 29, 2003 have been fully considered but they are not persuasive.

On lines 3-7 of page 10 of the remarks, Applicant asserts that part 18 of Paris is under pins 11 and 12, which allegedly fails to satisfy the limitation requiring the lower part of each branch to be housed above one part of the side part of the heel piece. Although the lowermost tip of arm 18 is below pins 11 and 12, most of the lower portion of arm 18 is above pins 11 and 12. Moreover, the claim only requires some portion of the lower part of arm 18 to be above one part of the side part of the heel piece, which the system of Paris certainly satisfies.

Also, the stop means 16, 17, and 20 of Paris the shoe and heel piece from sliding in the base due to the inherent nature of their structure. Means 16, 17, and 20 are

configured to prevent such motion and there is no suggestion in Paris that they allow sliding.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Bottorff whose telephone number is (703) 308-2183. The examiner can normally be reached on Mon.-Fri. 7:30 a.m. - 4:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Johnson can be reached on (703) 308-0885. The fax phone numbers




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for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.



Christopher Bottorff  
June 30, 2003



BRIAN L. JOHNSON  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600 7/2/03